

REMARKS/ARGUMENTS**1.) Claim Amendments**

Claims 1-2, 7-9, 11-12, and 37-50 are pending in the application. They have not been amended, but a courtesy copy of the claims is provided above. Claims 3-6, 10 and 13-36 have been previously canceled.

2.) Claim Rejections – 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 2, 7, 11, 12, 37-42 and 44-49 under 35 U.S.C. § 102(b) as being anticipated by Welling (GB 2 300 334). The Applicant respectfully traverses this rejection.

For discussion purposes, claim 1 is reproduced below:

1. A method of negotiating operating capabilities in a telecommunications system including at least one mobile station, the method comprising:

receiving a first list of operating capabilities for a first mobile station at a first node upstream of and associated with the first mobile station wherein the list is received prior to setting up a call with the mobile station,

storing the operating capabilities for the first mobile station at the first node,

receiving a second list of operating capabilities for a second mobile station at a second node upstream of and associated with the second mobile station wherein the list is received prior to setting up the call with the second mobile station,

storing the operating capabilities for the second mobile station at the second node,

comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node.

The Office Action claims that the element of "comparing the second list to the first list" is taught by Welling. The Applicant respectfully disagrees. The passage cited by the Office Action is cited below:

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The technique provides integration of the special service point (SSP) functions into the mobile network. This creates a node which combines MSC, VLR and SSP functionality.

Advantageously, the mobile network incorporates means for providing a mapping between its own call model and other proprietary call models that may be employed by various intelligent network nodes. Welling, page 3, lines 11-17.

The Applicant fails to understand how this cited passage of Welling reads on the claim limitation of "comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node." Admittedly, the passage from Welling teaches a mapping. However, a mapping is not a comparing such that a negotiation takes place between the first node and the second node. The Applicant respectfully maintains that this claim element is simply not taught nor inherently described by Welling.

As the PTO provides in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim...." Therefore, Welling must disclose all of the elements of the claims to sustain the rejections. Clearly, Welling does not teach this claim element.

MPEP § 2131 requires that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." Claim 1 recites comparing the second list to the first list such that the negotiation of agreed upon operating capabilities take place between the first node and the second node. In contrast, nowhere does Welling teach or suggest a comparison which leads to a negotiation. Accordingly, Welling fails to disclose or suggest all the claimed elements or the manner in which they interconnect as required by MPEP § 2131.

Additionally, claim 1 is directed to receiving and storing the "operating capabilities" of the two mobile stations. Nothing in Welling is directed to the "operating capabilities" of the mobile stations. Although Welling teaches the storing of location information, one skilled in the art would readily recognize that the stored information is not "operating capabilities." Thus, it is clear that Welling does not teach every element of claim 1. Claim 1, therefore, is allowable over Welling.

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Independent claims 37 and 44 contain similar elements which are also not found in Welling. Thus, claims 37 and 44 are allowable for similar reasons. The dependent claims depend from the independent claims and recite further limitations in combination with the novel elements of the independent claims. Therefore, the allowance of the dependent claims is also respectfully requested.

3.) Claim Rejections – 35 U.S.C. § 103(a)

The Examiner rejected claims 8, 9, 43 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Welling. The Applicant respectfully traverses this rejection.

As provided in MPEP § 2143, "[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP § 2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office Action does not factually support a prima facie case of obviousness for claims 8, 9, 43 and 5 based on Welling.

The Examiner admits that all the elements of claims 8, 9, 43 and 50 are not taught by Welling and has used "official notice" to justify this rejection. As the Examiner is aware, in order preserve the Applicant's right to traverse this assertion in later actions, the Applicant must traverse this assertion in this Office Action. Therefore, the Applicant respectfully objects to the Examiner's use of official notice. Under MPEP § 2144.03, official notice may only be taken of "facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." When a rejection is based on facts within the personal knowledge of the Examiner, the facts must be as specific as possible, and the reference must be supported, when called for by the applicant, by an affidavit of the Examiner, which may be subject to explanation by the Applicant. 37 CFR 1.104(d)(2).

Pursuant to 37 CFR 1.104(d)(2), the Applicant respectfully requests the Examiner provide such supporting facts and evidence in the form of an affidavit, so that, if necessary, the Applicant may have a chance to explain the reference in later actions. In any event, as explained above with respect to the 102 rejection, Welling does not teach all of the elements of the independent claims. Similarly, Welling does not teach

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all of the elements of the dependent claims. So, according to the MPEP 2143, an obvious rejection is not proper and should be withdrawn.

CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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